

DOCKET NO. 05-03-002
CLIENT NO.: UGSC01-05017
Customer No. 45113

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : NILANJAN MUKHERJEE
U.S. Serial No. : 10/716,386
Filed : November 18, 2003
For : SYSTEM, METHOD, AND COMPUTER PROGRAM
PRODUCT FOR SMOOTHING
Group No. : 2128
Examiner : Herng Der Day

MAIL STOP PETITION
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Sir:

RENEWED PETITION UNDER 37 CFR 1.137(b)

Applicant respectfully requests reconsideration of the Decision on Petition mailed June 4, 2008, dismissing the petition filed May 4, 2007, in light of the arguments and information submitted below.

REMARKS

The Decision on Petition mailed June 4, 2008, dismissed the Petition for Revival of an Application for Patent for Failure to Notify the Office of a Foreign or International Filing (37 CFR 1.137(f)), which is hereby incorporated by reference. The Decision indicated that the Petition, filed on form PTO/SB/64a, was treated as a petition under 37 CFR 1.137(b) to revive an application abandoned for unintentional delay in filing a required reply. For a grantable petition under 37 CFR 1.137(b), the rules require:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(l);
- (3) A showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

Items (1)-(3) were filed with the Petition filed May 4, 2007; item (4) is not required in this instance. With regard to item (3), form PTO/SB/64a includes a statement, made by the undersigned, that the entire delay was unintentional. While this is a sufficient showing in most cases, in the Decision, the Petitions Examiner indicates that the delay has not been shown to be unintentional for two periods of time:

- (1) the delay in reply that originally resulted in the abandonment; and
- (2) the delay in filing an initial petition pursuant to 37 CFR 1.137(b) to revive the application.

Applicant and the undersigned respectfully submit the following information to show that the entire delay, including the time periods referenced above, was unintentional.

1. Provisional Application 60/498,085 was filed on **August 26, 2003**.
2. This application was filed on **November 18, 2003**, claiming the benefit of the filing date of Provisional Application 60/498,085. A Nonpublication Request was filed with this application, and this application was assigned to Electronic Data Systems Corporation (EDS).
3. Effective **May 10, 2004**, this application was assigned by EDS to UGS PLM Solutions, Inc., later UGS Corp. (UGS).
4. The undersigned filed an Information Disclosure Statement (IDS) in this case, with the Applicant's approval, on **June 22, 2004**.
5. A corresponding PCT Application was filed on **August 10, 2004** by Applicant UGS Corp. directly, and not by the undersigned. UGS inadvertently did not file a Rescission of Previous Nonpublication Request and Notice of Foreign Filing (collectively, the "Rescission Notice"), and the undersigned was unaware at the time of the PCT filing. The UGS staff person that prepared the PCT filing is no longer

employed by the company, but indicated at the time of the original petition that the failure to file this notice was an unintentional oversight.

6. On **September 25, 2004**, this application was automatically abandoned for failure to file the Rescission Notice within 45 days of the PCT filing. The failure to file the Rescission Notice, and the entire delay in this 45 days, was unintentional on the part of the Applicant, and the undersigned was unaware of the PCT filing at all during this time. Neither the Applicant, the undersigned, nor the Office was aware that this application had become abandoned.
7. On **December 10, 2004**, an IPER and Written Opinion in the PCT application were mailed to UGS. UGS forward these to the undersigned on January 3, 2005.
8. On **January 11, 2005**, at the Applicant's instruction, the undersigned filed an IDS in this application to disclose the art cited in the PCT application. This filing illustrates that the Applicant and undersigned were unaware that the application had abandoned, and so the delay in filing an initial petition to revive was unintentional.
9. On **January 8, 2007**, the Office mailed a first Office Action on the merits in this application.
10. On **April 4, 2007**, at the Applicant's instruction, the undersigned filed an Amendment and Response to the January 8, 2007, Office Action. This filing illustrates that the Applicant and undersigned were unaware that the application had abandoned, and so the delay in filing an initial petition to revive was unintentional.

11. On **April 12, 2007**, at the Applicant's instruction, the undersigned filed an IDS in this application to provide specific references requested by the Examiner in this application. This filing illustrates that the Applicant and undersigned were unaware that the application had abandoned, and so the delay in filing an initial petition to revive was unintentional.
12. On **April 25, 2007**, after an inquiry by the inventor, the undersigned noted that this application had not yet been published, though a PCT application had been filed by the Applicant. The undersigned inquired of the Applicant, who indicated that no Rescission Notice had been filed. The undersigned thereafter determined that this application had been abandoned automatically in September 2004, and telephoned the Examiner to notify the Office that the application was abandoned for failure to timely file the Rescission Notice. The Examiner in this case indicated that the Notice of Abandonment would be mailed to complete the record, though the undersigned indicated that a petition to revive would be promptly filed.
13. On **May 4, 2007**, the undersigned filed the Petition for Revival of an Application for Patent for Failure to Notify the Office of a Foreign or International Filing (37 CFR 1.137(f)), including all required parts.
14. On **July 2, 2007**, the Office mailed a Notice of Abandonment.

As illustrated above, the initial "delay in reply that originally resulted in the abandonment" was a result of unintentional oversight on the part of a staff person then in the Applicant's employ.

This delay was unintentional on the part of the Applicant as it was caused by an oversight by UGS to rescind a notice filed on behalf of EDS, and was unintentional on the part of the undersigned, as the undersigned was unaware at the time of the PCT filing.

The initial Petition was not filed for over two years and seven months following statutory abandonment simply because neither the Applicant, the undersigned, nor the Office were aware that the application had been abandoned. This was certainly not intentional on the part of the Applicant or undersigned, and all parties continued to prosecute the application in the belief that it was still pending at the Office. When the error was discovered, the Office was promptly notified and a petition to revive was timely filed.

The Decision on Petition indicates that “Here, in view of the inordinate delay (almost 3 years) in resuming prosecution, there is a question of whether the entire delay was unintentional.” Applicant respectfully notes that, while there was a delay in filing the required Rescission Notice, because the Applicant and undersigned were unaware of the oversight, there was no delay at all in prosecution – the Examiner sent a first Office Action in the normal course of his docket, and the Applicant timely replied. The file history clearly indicates that the Applicant did not intend any delay in response or for the application to be abandoned.

The Decision includes several specific inquiries, addressed below.

- On page 2 of the Decision, the Office indicates that “the counsels of record ... should explain why this application became abandoned while it was under their control and what efforts were made to further reply and with whom this matter was discussed outside of

their Office.” The abandonment occurred without any knowledge at all on the part of the undersigned, as the required filing resulted from a PCT filing made directly by the assignee/Applicant and not communicated to the undersigned before the application was abandoned. The matter was only discussed with the Applicant when the abandonment was discovered over two and a half years later.

- On page 2 of the Decision, the Office indicates that “Copies of any correspondence relating to the filing, or not filing a reply are required from the responsible persons and whoever else was involved with this application at the time of the abandonment.” There is no correspondence at all relating to the filing (or non-filing) of the Rescission Notice, as the failure to file was an oversight. The nearest-in-time correspondence is a June 24, 2004 standard “foreign filing reminder” letter to remind the Applicant of the August 26, 2004 foreign filing deadline, and indicating that the undersigned would not file a foreign application without instructions. No response was received. The next correspondence was a letter from the Applicant enclosing a copy of the IPER and Written Opinion in the PCT application, dated January 3, 2005, after this application was statutorily abandoned without the Applicant’s knowledge. The Applicant filed the PCT application directly, and did not provide a copy to the undersigned. If the Office requires a copy of the correspondence indicated above, the undersigned will be pleased to provide it.
- On page 3 of the Decision, the Office indicates that applicants should include the date that the applicant first became aware of the abandonment of the application and a

showing as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of the applicant. The undersigned first became aware of the abandonment of the application on or about April 25, 2007, after determining that the Rescission Notice had not been filed and researching the consequences of this oversight. The undersigned promptly notified both the Applicant and Office of the abandonment, and promptly filed the initial Petition. The delay in discovering the abandoned status resulted from the fact that both the Applicant and the Office were prosecuting/examining the application normally, and in this case, there is nothing at all in the file that would indicate that the application had been abandoned. Indeed, the initial Petition was filed nearly two months *before* the Office mailed a Notice of Abandonment.

The undersigned states that all statements made above with regard to actions taken by the undersigned or facts known to the undersigned at a given time (*i.e.*, all statements regarding the first-hand knowledge of the undersigned) are true, and all other statements are true on information and belief.

The above is believed to be a complete and sufficient showing that the entire delay since the failure to file the Rescission Notice and subsequent abandonment was unintentional on the part of the Applicant, including the two periods of time specifically questioned by the Petitions Examiner. If any other information would be helpful to the Petitions Examiner, she is respectfully requested to

telephone the undersigned. The undersigned would be pleased to provide any other information available that may be helpful in granting this petition.

A Statement of Allen Scott Lineberry, in-house counsel for Applicant, is enclosed.

CONCLUSION

As a result of the foregoing, Applicant respectfully requests reconsideration of the Decision on Petition, and that the Petition for Revival of an Application for Patent for Failure to Notify the Office of a Foreign or International Filing be granted.

If any issues arise, or if the Examiner has any suggestions or questions, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *manderson@munckcarter.com*.

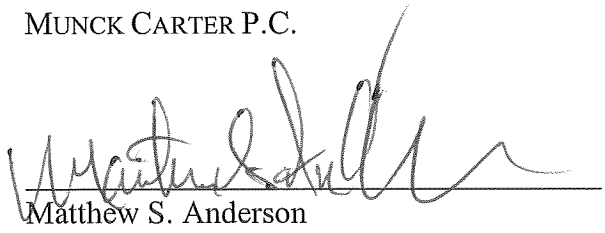
The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK CARTER P.C.

Date: _____

3/4/8



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Examiner : Herng Der Day

MAIL STOP PETITION
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Sir:

STATEMENT OF ALLEN SCOTT LINEBERRY

In support of the Renewed Petition under 37 CFR 1.137(b), I make the following statements.

1. My name is Allen Scott Lineberry. I am an attorney in good standing in the State of Texas and am registered to practice before the USPTO.
2. International Application Number PCT/US2004/025812 (the "PCT Application") was filed on December 10, 2004, by and on behalf of UGS Corp. The PCT Application corresponds to U.S. Patent Application 10/716,386 filed on behalf of Electronic Data Systems Corporation ("EDS") on November 18, 2003 ("the '386 Application").

3. At the time of filing of the PCT Application, I was in-house counsel for UGS Corp. I am currently in-house counsel for Siemens Corp., the parent company of Siemens Product Lifecycle Management Software Inc., which is a successor of UGS Corp.
4. The PCT Application was prepared by my assistant at my direction. This assistant is no longer employed by UGS Corp. or its related companies.
5. When UGS filed the PCT Application, I was unaware that a Non-Publication Request had been filed in the '386 Application. The failure to file a Rescission of Previous Nonpublication Request and Notice of Foreign Filing (collectively, a "Rescission Notice") was inadvertent on my part and on the part of UGS Corp. The entire delay in filing the Rescission notice within the required 45 days after the filing of the PCT Application was unintentional.
6. It is my practice, and was the practice of UGS Corp., to file a Rescission Notice when filing a foreign counterpart to a U.S. patent application in which a Non-Publication Request had been filed.
7. I was unaware that the '386 Application was statutorily abandoned on or about September 25, 2004.
8. On or about January 3, 2005, I instructed outside counsel to file an Information Disclosure Statement ("IDS") corresponding to an IPER and Written Opinion received in the PCT Application. This act illustrates that UGS Corp. was unaware

that the '386 Application had been statutorily abandoned and that the delay in filing an initial petition to revive was unintentional.

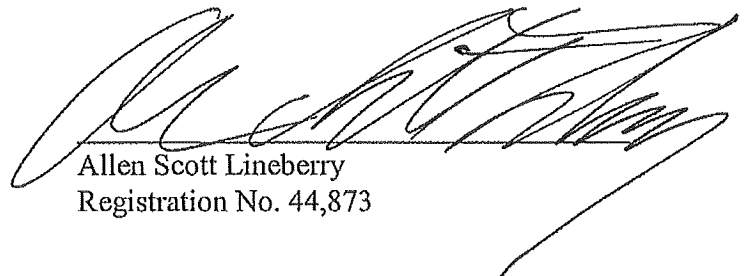
9. On or about January 23, 2007, I instructed outside counsel to prepare and file a response to a first Office Action on the merits in the '386 Application and a corresponding IDS. This act illustrates that UGS Corp. was unaware that the '386 Application had been statutorily abandoned and that the delay in filing an initial petition to revive was unintentional.
10. I became aware that the '386 Application was statutorily abandoned on or about April 25, 2007 when outside counsel informed me that no Rescission Notice had been filed in the '386 Application and the '386 Application had therefore been automatically abandoned in September 2004. At that time, I instructed outside counsel to prepare a Petition for Revival of an Application for Patent for Failure to Notify the Office of a Foreign or International Filing (37 CFR 1.137(f)). This act illustrates that UGS Corp. was unaware that the '386 Application had been statutorily abandoned and that the delay in filing an initial petition to revive was unintentional.
11. The initial "delay in reply that originally resulted in the abandonment" was a result of unintentional oversight on the part of UGS Corp. to rescind a notice filed on behalf of EDS. Neither I nor UGS Corp. intended this delay.

12. The initial Petition was not filed for over two years and seven months after the '386 Application was automatically abandoned because neither I nor UGS Corp. were aware that the application had been abandoned.
13. The entire delay for filing the required Rescission Notice until the '386 Application was automatically abandoned was unintentional and the entire delay between the unintentional abandonment of the '386 Application until initial petition to revive was filed was unintentional. I instructed that the petition to revive be filed as soon as I was aware that the '386 Application was abandoned.

I declare that all statements made above with regard to my actions or facts known to me at a given time (*i.e.*, all statements regarding my first-hand knowledge) are true and correct, and all other statements are true on information and belief.

Date:

4 August 2008



Allen Scott Lineberry
Registration No. 44,873